

REMARKS

Claims 1 through 5 remain in the application. Basis for the amendment to claim 5 may be found, for example at page 1, first paragraph, at page 3, last paragraph and in the examples. No new matter is contained in these amendments.

Applicants submit the present amendments and remarks, and respectfully request reconsideration and allowance of the remaining claims.

I. Claim Objections

a. Claims 1 & 4

Claims 1 and 4 are objected to because of the following informalities: Specifically regarding claims 1 and 4, the examiner alleges the limitation “retanning agent” is not supported by the specification. The examiner finds support for tanning agents on page 4, last paragraph to page 5.

The examiner’s attention is directed to page 3, first full paragraph of the present specification in connection with the underlying problem that the desired agent is supposed to include lubricants, retanning agents, substances regulating the pH-value and optionally further additives as components. Moreover, when referring to the inventive liquid agent, the specification on the same page, last paragraph, explicitly discloses that this inventive agent includes retanning agents. Thus, the use of this term in claims 1 and 4 is supported by the present specification. The paragraph cited by the Examiner on page 4 only elucidates that well-known vegetable and synthetic tanning agents may be used as retanning agents.

Reconsideration and withdrawal of this objection is respectfully requested.

b. Claim 5

Claim 5 remains objected to for not referring to multiple claims in the alternative only. Claim 5 has been amended to correct this deficiency. Reconsideration and withdrawal of this objection is respectfully requested.

II. Rejection of Claims under 35 U.S.C. § 112

Claim 5 stands newly rejected as being indefinite for allegedly lacking any steps in the claimed method. The claim has been amended to set forth positive steps for the methods. Reconsideration and withdrawal of this rejection is respectfully requested.

III. Rejection of Claims under 35 U.S.C. § 102(b)

a. **Hopkins *et al.*** (U.S. Patent No. 4,560,386)

The examiner maintains the rejection of claims 1-5 because allegedly the product claimed is the same as the product of the prior art. Applicants respectfully traverses this rejection.

The specification discloses, at page 4, first full paragraph, that oxidative treatment of the unsaturated fat results in a reduction of the iodine number by at least 20 units. The change in iodine number is a result of change in chemical structure, namely a change in the number of double bonds. Hopkins *et al.* does not disclose the use of unsaturated fatty acids as starting materials for production of the lubricant, as is claimed in claim 1. For these reasons, the claimed product and the product of the prior art are not the same, as has been alleged. Reconsideration and withdrawal of this rejection is respectfully requested.

b. **Friese *et al.*** (U.S. Patent No. 4,903,362)

The examiner has rejected claims 1-5 as being anticipated under 35 U.S.C. § 102(b) by Friese *et al.* because Friese *et al.* allegedly teach oxidation of fats with oxygen-containing gas mixtures to produce sulfitable fats having iodine numbers below 100, for example. Applicants respectfully traverses this rejection.

The invention includes a liquid tanning agent which is stable on storage and in emulsion and comprises a lubricant, retanning agent and substances regulating pH value, as well as optional other components, wherein unsaturated fats, oils or waxes are used as starting materials to produce said lubricant, and are subjected to oxidative treatment prior to further chemical reaction. Friese *et al.* disclose use of *sulfited* fats produced by oxidation of fats with oxygen-containing gas mixtures and simultaneous or subsequent *sulfitation* using alkali and/or ammonium hydrogen *sulfites*. See abstract and Column 2, lines 8-11 (emphasis added). As

disclosed at page 4 of the instant specification, the oxidation process is followed by chemical reaction to yield the claimed lubricant. The chemical reaction includes *sulfation*, sulfochlorination, phosphating, ethoxylation, amidation or by preparing the corresponding *sulfosuccinates*. Instant specification, page 4, second full paragraph (emphasis added). Nowhere does the instant specification disclose the use of sulfites, as taught by Friese *et al.* Nowhere does Friese *et al.* disclose any of the recited chemical processes, which are also claimed in present claim 3. Friese *et al.* cannot produce the same chemical lubricant since different chemical reactions are utilized in the prior art and present inventions. For these reasons, Friese *et al.* cannot anticipate the claimed invention. Reconsideration and withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims under 35 U.S.C. § 103(a)

a. **Hopkins *et al.* (U.S. Patent No. 4,560,386)**

The examiner has maintained the rejection of claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Hopkins *et al.* The examiner previously stated that Hopkins *et al.* does not disclose a reduction in iodine number after oxidation treatment. The examiner further stated that it would have been obvious to one of ordinary skill in the art to formulate a liquid agent for oxidative treatment to reduce the iodine number of a liquid agent. Applicants respectfully traverse this rejection.

The examiner's contention that the deficiencies of Hopkins *et al.* are cured by knowledge available to one of ordinary skill in the art is in error, since this contention has not been supported with any objective evidence or sound scientific reasoning. "Rarely . . . will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment . . . Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case" *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999). Moreover, an obviousness conclusion must be based on *facts*, rather than on generalities (such as a general and/or unsupported statement of knowledge available in the art). *See In re Warner*, 379 F.2d 1011, 1017 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968); *see also In re Freed*, 425 F.2d 785, 788 (C.C.P.A. 1970). The Examiner's contention that one of ordinary skill would have been motivated to have combined the uncited teaching to formulate a liquid agent for

oxidative treatment to reduce iodine number of a liquid agent is not based on any statement in any reference, on sound scientific reasoning available in the art, or any other actual evidence.

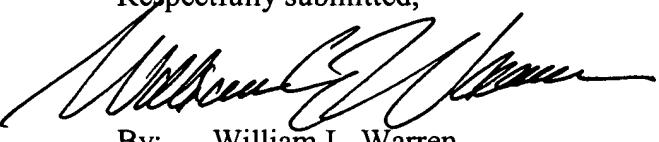
Since the Examiner has provided no actual evidence to support the conclusory statement that it would have been obvious to one of ordinary skill in the art to formulate a liquid agent for oxidative treatment to reduce iodine number of a liquid agent, Applicants respectfully assert that a *prima facie* case of obviousness has not been established. Reconsideration and withdrawal of this rejection is respectfully requested.

V. Conclusions

All of the stated ground of rejection have been properly traversed, accommodated or rendered moot. Applicants therefore respectfully requests that the examiner reconsider and withdraw all of the outstanding rejections.

It is believed that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the examiner believes, for any reason, that personal communication will expedite prosecution of this application, the examiner is encouraged to call the undersigned attorney at 404-853-8081.

Respectfully submitted,



By: William L. Warren
Reg. No. 36,714

SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street
Atlanta, Georgia 30309
(404) 853-8000 / (404) 853-8081 (direct)
SAB Docket 18584-0003